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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,506	10/31/2003	Vincent Vaccarelli	LEAP:129US	9595
7590	10/24/2005		EXAMINER	
Robert P. Simpson, Esq. Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221-5406			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/698,506

Applicant(s)

VACCARELLI, VINCENT

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Amendment***

1. The present Office action is made in response to the amendment of 10/11/2005. It is noted that in the amendment, applicant has amended claims 14 and 19 and canceled claims 2 and 8-9. The remaining claims 1, 3-4 and 10-22 are examined in this Office action. Note that claims 5 and 7 were canceled in the amendment of 12/17/2004 and claim 6 was canceled in the amendment of 5/4/2005.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-4, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al and Olofson (all of record).

Robinson, Jr. discloses a glass microscope slide having an opaque marking surface formed thereon. The marking surface may be formed on either end of the slide. In other words, in the embodiment as described in columns 2-4 and shown in figs. 3-4, the slide (20) comprises two marking surfaces (24) formed on the same side and on two opposite ends of the slide and an area defined between the two marking surfaces, as understood, is used to support a specimen. The marking surface is made by colored material. However, Robinson, Jr. does not clearly disclose that printed information is provided on the marking surface as claimed.

The use of a slide having printed information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas in which the central area is used to support a specimen and one of the areas (20a, 20b) located on a side of the central area is used to support printed information (22) which information is in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient having the specimen in the slide wherein the information is readable by either a human being or a machine. The combined product as provided by Robinson Jr. and Domanik et al does not clearly disclose that one of the marking surfaces is used for information readable by a machine or a human being and the other

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marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of two marking surfaces wherein one surface is coated by removably coating (14) in which information (28) is provided and another surface area separately from the surface contained the information (28) is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr. and Domanik et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

4. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al and Olofson as applied to claim 1 above, and further in view of Speelman (of record).

The combined product as provided by Robinson, Jr. , Domanik et al and Olofson as described above does not disclose that the slide has four round corners and a surrounding edge of a trapezoidal configuration as

claimed in present claims 10 and 13, respectively. However, the use of a slide made by a transparent material and is used to support a specimen wherein the slide has four round corners and a surrounding edge of a trapezoidal configuration is known in the art as can be seen in the slide provided by Speelman. In particular, in columns 1-2 and figs. 1-2, Speelman discloses a slide (10) has four round corners (20) and a surrounding edge (18) so that a use can use the slide for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user (see column 1). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr., Domanik et al and Olofson by making the corners of the slide as round corners and the edge as an edge having a trapezoidal configuration as suggested by Speelman for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user.

Regarding to the feature related to the shape of the surrounding edge of the slide, i.e., a round configuration or a triangular configuration, as recited in present claims 11-12, such a recitation is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present claim 13 in which applicant has claimed that the surrounding edge of the slide has a trapezoidal configuration. It is also noted that it would have been an obvious matter of design choice to one skilled in the art to utilize any suitable shape for the edge of the slide

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for the same purpose since it was decided in the Courts that a change in shape is generally recognized as being within the level of ordinary skill in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

5. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al, Olofson and the prior art described in column 2 of Patent issued to Rosenlof et al (all of record).

Robinson, Jr. discloses a glass microscope slide having an opaque marking surface formed thereon. The marking surface may be formed on either end of the slide. In other words, in the embodiment as described in columns 2-4 and shown in figs. 3-4, the slide (20) comprises two marking surfaces (24) formed on the same side and on the two opposite ends of the slide and an area defined between the two marking surfaces, as understood, is used to support a specimen. The marking surface is made by colored material. However, Robinson, Jr. does not clearly disclose that printed information is provided on the marking surface as claimed.

The use of a slide having printed information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas in which the central area is used to support a specimen and one of the areas (20a, 20b) located on a side of the central area is used to support printed

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information (22) which information is in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient having the specimen in the slide wherein the information is readable by either a human being or a machine.

Regarding to the feature related to the use of a sticker for carrying a printed representation as recited in claim 19, such a feature would have been obvious to one skilled in the art because the use of an opaque label for a microscope slide is stated/described in the prior art provided on column 2, lines 1-4 of the Patent issued to Rosenlof et al. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the label carrying readable information provided by Robinson, Jr. and Domanik et al by using an opaque label as suggested by the prior art described on column 2 of the patent issued to Rosenlof et al for carrying the readable information.

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The combined product as provided by Robinson Jr. , Domanik et al and the prior art described in column 2 of patent issued to Rosenlof et al does not clearly disclose that one of the marking surface is used for information readable by a machine or a human being and the other marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of two marking surfaces wherein one surface is coated by removably coating (14) in which information (28) is provided and another surface area separately from the surface contained the information (28) is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr., Domanik et al and the prior art described in column 2 of patent issued to Rosenlof et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

***Response to Arguments***

6. Applicant's arguments filed 10/11/2005, pages 5-8, have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding to the applicant has argued that the art of Robinson discloses that the slide does not need opaque background coating on the reverse side of the slide and the art of Olofson discloses a slide having two opaque coatings on the same end and opposite sides of the slide, the Examiner offers the following opinions.

In response to applicant's argument related to the difference in structure of the slides provided by Robinson and Olofson, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant should note that the Examiner has not tried to obtain a product by combination two slides having different structures as provided by Robinson and

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Olofson into one product. Applicant is respectfully invited to review the rejection in which the art of Olofson is used in the rejection for the purpose of showing to one skilled in the art the fact that a slide has an area for carrying a preparation/object and two areas which contains different information related to a preparation/object.

Regarding to the manner in which the information is printed into the nontransparent area of the slide, applicant's arguments as provided in the amendment, page 6 have been fully considered but they are not persuasive. Applicant should note that the present claims just recite two areas for carrying different printed information. How the printed information is formed is not recited in the claim and also is not related to the structure of the slide as claimed. The device as claimed is directed to a slide having a first area for supporting a preparation and two areas on opposite sides of the first area for supporting different information of the preparation. In this aspect then the combined product provided by Robinson, Domanik et al and Olofson meets all of the features of the device claimed in the present claims. Again, the art of Olofson is used in the rejection for the purpose of showing to one skilled in the art the fact that a slide has an area for carrying a preparation and two areas which contains different information related to a patient/object.

Regarding to the arguments provided in the amendment, pages 7-8, since the applicant has not provided any different arguments except referring to the deficiencies of art provided by Robinson, Domanik et al and Olofson,

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which the examiner has not agreed thereon as provided above, thus the claims 10-13 and 19-22 are still rejected for the same reasons as set forth in the previous Office action and now repeated in this Office action.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

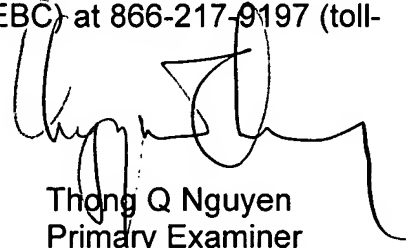
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen  
Primary Examiner  
Art Unit 2872